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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,255	01/24/2002	Robert Douglas Hamilton	SAB-027	6731

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GORDON & JACOBSON, P.C.  
60 LONG RIDGE ROAD  
SUITE 407  
STAMFORD, CT 06902

EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/055,255

Applicant(s)

HAMILTON, ROBERT DOUGLAS

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. In view of the appeal brief filed on October 21, 2004 ("First Appeal Brief") and Applicant's amendment also filed on October 21, 2004, PROSECUTION IS HEREBY REOPENED. A Final Office Action is set forth below.
2. To avoid abandonment of the application, Applicant must exercise one of the following two options:
  - (1) a reply under 37 C.F.R. §1.111 or,
  - (2) request reinstatement of the appeal.
3. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 C.F.R. §§ 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 C.F.R. §1.193(b)(2).
4. Applicant's amendment filed October 21, 2004 is acknowledged. Accordingly, claims 1-38 remain pending.
5. Claims 33-38 were withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
6. The Examiner notes that because the previous Office Action ("Second Non Final Office Action" mailed February 18, 2004) was non-final, Applicant's amendment filed October 21, 2004 must be entered.
7. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or

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“applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.

### ***Drawings***

8. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

- i. The “interfaces comprises an HTML page” as recited in claim 13
- ii. The “computing device comprises a personal digital assistant” as recited in claim 2
- iii. The “computing device comprises a cellular telephone” as recited in claim 22.

9. The Examiner notes the claims are replete with the above drawing errors. All method steps recited in the claims are clearly not shown in the drawings. The Examiner highly recommends Applicant review all pending claims to ensure that every structural feature claimed is shown in the drawings. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application.

### ***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

10. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-32 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claims 1, 27, and 28, it is unclear as to whom the “remotely tuning” is performed. Remote to the customer or remote to the server cable company? For prior art purposes only, the Examiner considers the “remotely tuning” to be remote from the computing device.

b. In claim 2, it is unclear if “an indicator” is the same or different from “an indicator” as recited in claim 1. If Applicant’s specification permits, the Examiner suggests ‘a first indicator’ and ‘a second indicator.’

c. In claim 14, it is unclear as to what “in response thereto” Applicant is referring to.

d. Claim 26 is indefinite because it contains more than computer instructions making the scope of claim 26 unclear.

12. The Examiner finds that because the claims are rejected as being indefinite under 35 U.S.C. §112 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

***Claim Rejections - 35 USC §102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-9, 11-32, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Mourad et. al. (U.S. 6,078,961) (“Mourad”). Mourad discloses the claimed invention including remotely tuning one of said at least tunable media receivers over the cable television network (receiver 2).

15. Claims 1-32, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by over Theurer et. al. (U.S. 4,008,369 (“Theurer”). Theurer discloses the claimed invention include a CATV system (the cables connecting the components within 1).

***Claim Rejections - 35 USC §103***

16. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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17. Claims 1-9, 11-32, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Mourad in view of Baker et. al. (U.S. 5,583,561)(“Baker”).<sup>1</sup> It is the Examiner’s principle position that the claims are anticipated because of the inherencies noted above.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Mourad as taught by Baker to include the generic elements of a cable television system. Such a modification would have helped lower the cost of service per view for selective retrieval and distribution of digital video.

18. Claims 10, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Mourad in view of Geile et. al. (U.S. 6,279,158 B1)(“Geile”). Mourad discloses as discussed above but does not directly disclose bandwidth manipulation. Geile teaches indicators of bandwidth allocation.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Mourad as taught by Geile to include indicators of bandwidth allocation. Such a modification would have helped maximize the bandwidth.

19. It is the Examiner’s position that claim 27 is not patentably distinct from claim 1. Therefore a restriction at this time is improper.

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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20. Claims 1-32, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Theurer in view of Anderson (U.S. 6,148,142).<sup>2</sup> It is the Examiner's principle position that the claims are anticipated because the CATV system is inherent.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Theurer as taught by Anderson to include a cable television system. Such a modification would have helped increase the type of programming available.

21. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,<sup>3</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements<sup>4</sup> with the required clarity, deliberateness, and

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<sup>2</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

<sup>3</sup> See the Second Non Final Office Action, Paragraph No. 19.

<sup>4</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).



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precision.<sup>5</sup> Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,<sup>6</sup> Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R.

§1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>7</sup> to be his own lexicographer.<sup>8</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation . . . ." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>9</sup> The Examiner now relies heavily and extensively on this

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<sup>5</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>6</sup> See again the Second Non Final Office Action, Paragraph No. 19.

<sup>7</sup> Id.

<sup>8</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed March 7, 2005).

<sup>9</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim

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interpretation.<sup>10</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

22. Under the broadest reasonable interpretation standard noted above and unless modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary<sup>11</sup>) during ex parte examination.

23. The Examiner maintains his position regarding functional language as noted in the Second Non Final Office Action.

### ***Response to Arguments***

24. Applicant's arguments filed in their First Appeal Brief have been fully considered but they are not persuasive.

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are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

<sup>10</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”

<sup>11</sup> See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

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25. Regarding the objections to the drawings, Applicant argues that the features cited by the Examiner are species of generic claim features. While this may be true, the Examiner notes that Applicants have elected to *claim* both the generic and species features. Therefore both the generic and species must be shown in the drawings. To the extent that claimed features are not shown in the drawings, the Examiner will henceforth consider them as “conventional features” as noted in 37 C.F.R. §1.83(a). Applicant’s argument has therefore been considered but is not persuasive.

26. Regarding the 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections, they too are not persuasive. The Examiner maintains his position regarding remotely tuning.

27. Applicants argue that he “does not even have an opportunity to address these rejections.”<sup>12</sup> This argument is clearly without merit because Applicant’s First Appeal Brief was filed in response to a non final office action. Applicant clearly had an opportunity to address the rejections by filing a response in accordance with 37 C.F.R. §1.111. Instead, Applicant elected (as is his right) to appeal. However such arguments that Applicant did “not even have an opportunity to address these rejections” are not persuasive.

28. Applicant’s remaining prior art arguments have been considered but are not persuasive.

### ***Conclusion***

29. References considered pertinent to Applicant’s disclosure are listed on form PTO-892.

30. The following two (2) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100,

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<sup>12</sup> Applicant’s First Appeal Brief, Page 5, 3<sup>rd</sup> full ¶.

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1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

32. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work 6<sup>th</sup> Ed. by Ron White; and How the Internet Works, 6<sup>th</sup> Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of the entire application and all the art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

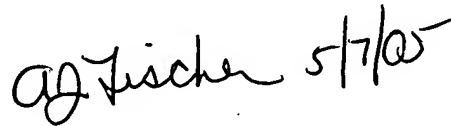
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33. Also in accordance with *In re Lee*, the Examiner finds that Nathan J. Muller's Desktop Encyclopedia of the Internet, ("Desktop Encyclopedia") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Muller's Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

34. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his arguments in the First Appeal Brief traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>13</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in

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accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
March 7, 2005

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<sup>13</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.